Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
71189-1300	

I hereby certify that this correspondence is being transmitted by facsimile to the U.S. Patent and Trademark Office to Examiner Necholus Ogden at (571) 273-8300.

on September 12, 2006

Signature Christine M Judge

Typed or printed name Christine M. Judge

Application Number	Filed
09/589,973	06/08/00

First Named Inventor: Eric J. Hansen

Art Unit	Examiner
1751	Necholus Ogden Jr.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 22,360
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

John E. McGarry
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John E. McGarry
Typed or printed name
616-742-3500
Telephone number
9-12-06
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Eric J. Hansen and Jesse J. Williams	
For:	EXTRACTION CLEANING WITH OXIDIZING AGENT	
Serial No.:	09/589,973	Examiner: Necholus Ogden Jr.
Filed:	06/08/00	Group Art Unit: 1751
Atty. Docket:	71189-1300	Confirmation No: 9893

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

☐ deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA, 22313-1450.

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Christine M. Judge
Signature

Date: September 12, 2006

Christine M. Judge
(type or print name of person certifying)

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

APPLICANT'S REASONS IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF REVIEW OF FINAL REJECTION

This paper is filed in support of Applicants Request for a Pre-Appeal Brief Conference in accordance with 1296 Off. Gaz. Pat. Office 67 (12 July 2005) entitled: "New Pre-Appeal Conference Pilot Program." (Extended January 10, 2006.) Applicants believe that the rejections of record are not proper and are without basis in fact or law. This request is based on a clear legal and/or factual deficiency in the rejections and not based on interpretation of claims or prior art teachings. In particular, the rejection of claim 21 and dependent claims 2-10, 12-16, 19, 20 and 22-28 is contrary to the decision of the Board of Patent Appeals and Interferences (BPAI) in this matter and is not supported in fact by the record. Further, the Examiner has not made a

prima facie case of unpatentability of claim 18 under 35 U.S.C. § 103 as required by *In re Vaeck* 947 F.2d 488, 20 USPQ 2nd 1438 (Fed. Cir. 1991).

The rejection of claim 21 and the claims dependent therefrom is contrary to the decision of the BPAI.

Claim 21 as amended following the decision by the BAPI reads as follows:

> 21. (Currently amended) A method for cleaning an upholstery or carpet surface in which a fluid carpet or upholstery cleaning solution is dispensed onto the upholstery or carpet surface to be cleaned and the cleaning solution is recovered from the surface with suction, comprising the steps of:
>
> admixing an oxidizing agent with the cleaning solution prior to the step of dispensing the cleaning solution onto the upholstery or carpet surface; and
>
> ~~according to claim 1 and further comprising the step of~~ heating the cleaning solution before the admixing step to heat the admixture.

See Amendment under 37 CFR § 1.197 filed October 13, 2005.

Claim 21 and the claims dependent therefrom have been rejected as unpatentable over Miracle et al. U.S. Patent No. 5,576,282 (Miracle et al. '282) in view of Perkins U.S. Patent No. 4,153,968 (Perkins '968). Although the McAllise et al. U.S. Patent No. 5,500,977 (McAllise et al. '977) has been cited in the rejection of claim 21 and claims dependent therefrom, it is clear from the Examiner's rejection that the McAllise et al. '977 patent has not been used in the rejection of claim 21.

Claim 21 was the subject of Appeal to the Board of Patent Appeals and Interferences. It depended of from claim 1 and added the limitation of "heating the cleaning solution before the admixing step to heat the admixture" as shown above. The Examiner had rejected these claims over the Miracle et al.'282 reference in view of the Ligman U.S. Patent No. 5,555,595 (Ligman '595 patent) or Sham U.S. Patent No. 5,386,612 (Sham '612 patent). In its decision of August 17, 2005, the BPAI held that the Miracle et al. '282 patent was properly combined with Sham '612 or with Ligman '595 as a prior art teaching of incorporating the Miracle oxidizing composition in either the Sham '612 or the Ligman '595 extraction cleaners to meet the limitations of claim 1. BPAI Opinion, p 3-5. Applicants do not dispute this holding of the BPAI.

The Perkins '968 reference discloses nothing more than what is disclosed in the Sham '612 or the Ligman '595 references with respect to the claimed invention. The Examiner has not articulated any differences between the Perkins '968 reference in either of the Sham '612 or the Ligman '595 references other than the disclosure in Perkins '968 reference that "two or more reservoirs could be used alternatively under different conditions". See Perkins '968, Column 9, lines 3-6. Therefore, Applicants believe that the decision of the BPAI with respect to the claims in this application controls and is the law of the case.

Turning now to the decision of the BPAI as it relates to amended claim 21, the BPAI's decision reads in relevant part as follows:

> Similarly, the references applied by the Examiner contain no teaching or suggestion of "the step of heating the cleaning solution before the admixing step the admixture" as recited in separately grouped claims 11, 17 and 21. Apparently in reference to these claims, the Examiner states "The order of mixing will not be given patentable weight in the absence of showing superior or unexpected results" (Answer, page 13). This wholly inappropriate statement is directly contrary to long-established precedents. *See, for example, In re Wilson*, 424F2nd 1382, 1385, 1 65USPQ 494, 496 (C.C.P.A 1970) (All words in a claim must be considered in judging the patentability of that claim against the prior art.) Under these circumstances, we again are compelled to hereby reverse the Examiner's § 103 rejection vis-à-vis claims 11, 17, and 21 as being unpatentable over Miracle in view of Ligman or Sham. (BPAI, page 7-8).

The Examiner's alleged combination of Miracle et al. '282 and Perkins '968 contains no teaching or suggestion of claimed step of "heating the cleaning solution before the admixing step to heat the admixture" which is the very same limitation that the BPAI found was not in the prior art references. The Examiner has not demonstrated any disclosure in this combined teaching of the step of heating a cleaning solution before admixing the cleaning solution with an oxidizing agent as required by claim 21. Thus, the rejection of a claim 21 and the claims dependent therefrom are unsupported by the rejection under 35 U.S.C. § 103(a) over the Miracle et al. '282 in view of the Perkins '968 reference and is inconsistent with the BPAI decision in this matter.

The Examiner has not made a prima facia case of unpatentability of claim 18.

Claim 18, the other independent claim in this application, differs from claim 21 in that it does not call for the step of heating the cleaning solution before the admixing step but calls for the step of mixing the admixture with heated air to heat the admixture and further calls for the step of heating the air before the step of mixing the admixture with heated air. See Amendment under 37 CFR § 1.197 filed October 13, 2005. The BPAI, in reversing the Examiner's rejection of this claim, in a footnote invited "the Examiner and the Appellants should consider and resolve whether the claims under consideration patentably distinguished over the combined teachings of Miracle and McAllise et al. patent (e.g. see Figures 8b and 11a, the paragraph bridging columns 8 and 9 as well as lines 11-26 in column 12)." (BPAI Opinion at page 7).

Claim 18 is now rejected over Miracle et al. '282 and Perkins '968 in further combination with McAllise et al. '977.[1]

The teaching of McAllise et al. '977 is set forth on Pages 2 and 3 of Applicants Response to Office Action filed on April 4, 2006. The Examiner has not made the required factual findings required under *In re Vaeck* 947 F.2d 488, 20 USPQ 2nd 1438 (Fed. Cir. 1991) to support this alleged combination of references. The Examiner has made no finding of fact as to how the disclosures of Miracle et al. '282, Perkins '968 and McAllise et al. '977 could be combined to meet the limitations of claim 18. See Applicants' Response filed April 4, 2005, p 5-6. However, even if the Miracle et al. '282 reference could be combined with the McAllise et al. '977 disclosure, the alleged combination does not meet claim 18.

There is no disclosure in McAllise et al. '977 as to the source of the "warm, moist exhaust air from motor fan 610" to which the Board and Examiner refer. The Examiner contends "McAllise et al. specifically teaches and discloses that the air is warmed by motor 610 prior to admixing with the cleaning solution at the discharge nozzle (Column 12, lines 11-26)." This allegation is not supported in fact in the McAllise et al. '977 reference. There is nothing in the

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1 It is significant that the BPAI could have but did not reject claim 18 over the combination of Miracle et al. '282 and McAllise et al. '977 but chose not to do so. Rather, the BPAI suggested that the Examiner give consideration as to whether or not claim 18 patentably distinguished over the combined teaching of Miracle et al. '282 and McAllise et al '977.

cited passage in McAllise et al. '977 that supports the Examiner's conclusion. The passage merely states that the motor *fan* 610, not the motor, discharges the air to nozzle 55. The cited passage discloses that air from the recovery tank 50 is drawn through the inlet plenum 619 of the motor fan via standpipe 612 and 572. This passage is clearly shown in Figures 2, 5, and 6 of McAllise et al. '977. This air passage completely avoids the motor 626 (see Figure 2). See also Column 3, lines 33-39, and Figures 2, 6, and 8b which disclose a separate cooling path for the motor 626, which is common in extractors. Therefore, it is quite clear from a reading of MacAllise et al. '977, that the Examiner's representation of heating of the exhaust air by motor 28 is without foundation in the McAllise et al. ' 977 reference and contrary to fact.

Thus, the Examiner's alleged combination of either Miracle et al. '282 and McAllise et al. '977 does not teach either of the following two steps:

- Mixing the admixture with heated air to heat the admixture; and
- Heating the air before the step of mixing the admixture with heated air.

Contrary to the Examiner's unfounded statements with respect to the disclosure in the McAllise et al. '977 patent, neither McAllise et al. '977, nor the alleged combination of the McAllise et al. '977 and Miracle et al. '282 disclose these claim limitations.

Conclusion

The rejections made by the Examiner in his final rejection of the claims are not supportable in law or fact as set forth above. Reversal of the Examiner's rejection is respectfully requested.

Respectfully submitted,
Eric J. Hansen and Jesse J. Williams

Dated: 9.12.06

By: _____

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